

No. 13,389

United States Court of Appeals  
For the Ninth Circuit

---

ROLLEY, INC.,

*Appellant,*

VS.

JAMES L. YOUNGHUSBAND and HOWARD  
YOUNGHUSBAND, co-partners, doing  
business as Consolidated Cosmetics  
and Les Parfums de Dana, Inc.,

*Appellees.*

Appeal from the United States District Court for the Northern  
District of California, Southern Division.

APPELLANT'S CLOSING BRIEF.

---

HARRY GOTTESFELD,

JOSEPH A. BROWN,

HUTCHINSON & QUATRIN,

55 New Montgomery Street, San Francisco 5, California,

*Attorneys for Appellant.*

FILED

DEC 16 1952



## Subject Index

---

	Page
Part One: Preliminary statement .....	1
Part Two: Analysis of appellees' brief .....	2
I. Appellees' remarks considered, categorically .....	2
II. Appellees' remarks considered, seriatim .....	3
A. Appellees' "statement of the case".....	3
B. Appellees' "argument" .....	5
1. Appellees' "title" .....	5
2. The sales of Tabu, Forbidden and Voodoo by appellees .....	6
3. The further references to Tabu, etc.....	7
4. The claim registration is prima facie evidence of ownership and use .....	7
5. The contention appellees are "entitled to their filing dates as first dates of use".....	9
6. The discussion of the "burden of proof"....	9
7. The asserted "background" of appellant....	10
8. The "analysis" of appellant's evidence.....	13
9. The further discussion of registration.....	14
10. The discussion of the cases .....	14
11. The cases originally cited by appellees.....	16
12. The claim the "public" associates Voodoo with appellees .....	16
13. The adjudication argument .....	17
14. The dismissal of the cross-complaint .....	17
15. The preliminary injunction .....	18
16. The claim appellant had a fair trial.....	18
Conclusion .....	19

## Table of Authorities Cited

---

### Cases

Pages

Penn Co. v. M.L.B. & T. Co., 72 Fed. 422 .....	12
The Trade Mark Cases, 100 U.S. 82 .....	15

### Statutes

Lanham Act, 15 U.S.C.A. 280 .....	6, 8
-----------------------------------	------

### Texts

52 Am. Jur. 139, para. 167, Trade Marks.....	9
Through the Looking Glass, Lewis Carroll, chapter 6 .....	7

**United States Court of Appeals  
For the Ninth Circuit**

---

ROLLEY, INC.,

*Appellant,*

vs.

JAMES L. YOUNGHUSBAND and HOWARD  
YOUNGHUSBAND, co-partners, doing  
business as Consolidated Cosmetics  
and Les Parfums de Dana, Inc.,

*Appellees.*

Appeal from the United States District Court for the Northern  
District of California, Southern Division.

**APPELLANT'S CLOSING BRIEF.**

---

**PART ONE: PRELIMINARY STATEMENT.**

Appellant is in receipt of copy of appellees' memorandum and submits its reply.

Appellees neither answer nor challenge appellant's statement of the case, the questions presented nor its analysis of the principles of law and equity to be applied herein. For this reason, we submit these matters upon appellant's opening brief and proceed directly to an analysis of appellees' discussion for such assistance as it may be.

**PART TWO: ANALYSIS OF APPELLEES' BRIEF.****I.****APPELLEES' REMARKS CONSIDERED, CATEGORICALLY.**

Appellees' memorandum will be of little value as an aid to decision herein for it cites neither fact nor precedent, nor any principle in support of the judgment below.

On the contrary, appellees perversely persist in arguing a case for the protection of TABU which is not involved and as to which neither an injunction nor any other relief was ordered. It is necessarily inferred, therefore, that appellees' intransigence in intruding a case that never existed is occasioned by their lack of valid comment upon the facts, issues and questions made by *the* record!

Appellant, admittedly, has never used nor threatened to use TABU or any variant or equivalent thereof in any connection, at any time, or in any manner. Yet, on at least 18 of the 51 pages of the memorandum, TABU is argued and reargued!

We respectfully submit appellees' submission, for these reasons, trifles the attention of the Court.

Appellees' presentation is further weakened by the pervading cynicism that mere bigness should prevail without regard to right, priority of appropriation and use of a trade-mark, or any other consideration recognized by law, much distasteful "name dropping", and fascination with large sums of money.

Since this attitude has no place in serious advocacy and cannot be expected to influence the Court in its

deliberations herein, we take no further notice of these extraneous, immaterial and distasteful remarks.

---

## II.

### APPELLEES' REMARKS CONSIDERED, SERIATIM.

#### A. APPELLEES' "STATEMENT OF THE CASE".

(pp. 3-4.)

Of the purportedly factual remarks at this place, it is necessary to note only three, namely that: (1) appellant "is dominated by its president"; (2) appellant's predecessor "copied" TABU; and (3) appellant's predecessor infringed TABU by the use (until 1943) of FORBIDDEN FLAME prior to the registration of FORBIDDEN (August 15, 1944, PX 100).

As to the first item, we do not apprehend the materiality of the point nor precisely what appellees intend by "domination" of appellant by its president. In any event the record (TR 112-113) is that Mr. Rolley owns 5,000 of the 8,250 issued shares and serves as president and manager subject to "permission of the board of directors."

Secondly, the reference to TABU—if material at all—is answered by the exclusive reference to the subject in this record as follows (TR 193-194):

"Q. Did you ever copy Tabu perfume?

A. I have copied Tabu. I have copied about 200 different perfumes in my *experiments*.

Q. Did you ever have anybody come to you with Tabu perfume and ask you to *make a reproduction of it*?



A. *No, sir.*

Q. But you have copied it?

A. I have copied about 200 different perfumes in my *experiments.*”

Neither the proof nor the decree suggests any infringement respecting TABU and that should have eliminated this item from further comment.

The appropriation of FORBIDDEN FLAME by appellant's predecessor can have no bearing, as its use was discontinued three years (in 1943) before appellant's existence (1946) and Mr. Rolley's use was prior to registration (August 15, 1944) or asserted appropriation by appellees (March 1, 1944, PX 100).

If appellees contend that TABU and FORBIDDEN are synonymous and interchangeable, then they stultify themselves—for it would be an obvious fraud upon the registration system to seek registration of FORBIDDEN if that name did not qualify as a trade-mark.

Appellees' summary of the findings (page 4) demonstrates the deficiency in the decree—transposed from appellees' complaint—that appellant has indeed used the mark VOODOO “later than the first use of the trade-mark” by appellees, *without, however, any finding whatever with respect to the prior appropriation by appellant's predecessor.* Appellees' own summation cannot avoid the patent and fatal negative pregnant in their pleading and decree!

In their statement of the questions presented, appellees plainly dissemble in suggesting that the in-



stant decree restrains appellant from a non-existent infringement of TABU and FORBIDDEN—because neither mark is anywhere mentioned or referred to in the decree (TR 45-47) or in the writ of injunction (TR 56-58).

B. APPELLEES' "ARGUMENT".

(pp. 5-48.)

1. Appellees' "Title" (pp. 5-6).

Appellees here repeat that they "own certain registration certificates," including only one here involved, but seek to accomplish a misrepresentation (page 5) as to ownership of the trade-mark VOODOO by a partial quotation of a stipulation designed to shorten the trial.

Appellant did *not* concede appellees' *title* to VOODOO and the representation to that effect is a fraud upon the Court and upon appellant. The cited statement, partially quoted by appellees, reads in full (TR 80):

"The Court. This is Voodoo?"

Mr. McKnight. Yes.

Mr. Hutchinson. Same objection on that, your Honor, with this further qualification, that the *registration without use does not prove any issue* in the case, and would not sustain judgment for the plaintiff.

The Court. I don't follow that clearly.

Mr. Hutchinson. This is with relation to Voodoo and *registration for Voodoo*. We do not challenge they have the certificate here, and do not raise any objection as to the foundation, but we think it is incompetent, irrelevant and imma-

terial, *because it does not establish the issues, which is prior use or, for that matter, any use.*”

The quotation from the Lanham Act (15 USCA 280 at pages 6-7) does support the judgment for that legislation merely declares that—

“. . . no rights may be claimed in the mark of another who *commenced* to use it *after* the *registration* issued . . .”

and the fact in this case is that appellant had used the trade-mark for more than one year before that act became law and more than three years before re-registration under the Lanham Act, its predecessor having used that mark for five years before any registration!

2. **The sales of TABU, FORBIDDEN and VOODOO by appellees (pp. 7-8).**

At this place appellees again resort to boastful name dropping—but with it all do not disclose to the Court the date, much less the first date, of any sale of VOODOO in the places mentioned and, at all times, *aggregate three marks*: TABU, FORBIDDEN and VOODOO, so that their argument, if they have one, is lost by their own diffusion.

The millions they discourse upon should certainly have produced *some evidence* of some specific use of VOODOO as a trade-mark *prior to 1949, if, in fact, it had ever been so used by appellees.*

3. The further references to TABU, etc. (pp. 9-12).

At this place, appellees further luxuriate in the dead issue of FORBIDDEN FLAME and conclude with a quite inexplicable attack upon the Court below for not having enjoined nonexistent infringement on TABU (page 12)!

At this point we are, like Alice, "too much puzzled to make any other remark."<sup>1</sup>

4. The claim registration is prima facie evidence of ownership and use (pp. 13-17).

It seems to us entirely futile to labor over the subject of "a prima facie case" when there has been plenary proof upon an issue.

Further, no conclusion derivable from a registration can be played back to a time before the date of appropriation claimed in the registration application, September 10, 1938, in the case of VOODOO.

Appellant's unchallenged proof is that the appropriation and use it may claim antedates appellees' claim to priority by four years or more.

Lest it be forgotten, it is noted that *plenary proof of appropriation and use in 1934*, and subsequently, is contained in *Mr. Rolley's deposition* in discovery, which appellees insisted upon reading into the record, as *a part of appellees' case in chief*, over appellant's timely objection. *This became appellees' evidence and they made no offer to impeach or counter it!*

---

<sup>1</sup>Through The Looking Glass, Lewis Carroll, Chapter Six.

In consequence, we submit the Court need not pursue appellees through their derivative contentions restricted to later periods. The issue was squarely presented at the outset of the trial and *the parties stipulated to a continuance to permit appellees to secure genuine and adequate proof on the issues of priority (TR 71-72) but appellees elected to rest upon secondary and substitute evidence* of the weakest possible kind and, necessarily, the Court must assume and presume that *further proof of higher quality would have been adverse to appellees by their suppression of it.*

Still further, the so-called prima facie showing appellees claim is available only as to August 9, 1949, and subsequently, when, it is conceded, that appellant had appropriated and was using VOODOO and, therefore, had not

*“commenced to use it after the registration issued”*

(15 USCA 280, quoted page 6 appellees' memorandum).

It is of the utmost significance that the trial Court did not indicate adoption of such fanciful notion of a “prima facie case”, as appellees now advance, and that appellees did not seek to reflect any such theory in the findings they submitted to that Court. These contentions are, therefore, as late as they are lame.

5. The contention appellees are "entitled to their filing dates as first dates of use" (p. 17).

If sustainable, this argument is beside the point. Appellant proved appropriation of VOODOO and use from 1934, whereas, appellees, at best, can only claim September 10, 1938, and have shown use only from 1949 onward.

6. The discussion of the "burden of proof" (pp. 18-20).

This argument proceeds upon the unorthodox assumption that a plaintiff does not have to prove his case. The novelty of the suggestion relieves the Court of the obligation of exploration.

The cases cited by appellees to this point (pp. 18-19) do not hold that the defendant has the burden of proof on any issue in a trade-mark case, any more than any other.

See:

52 *Am. Jur.* 139, para. 167, Trade-Marks.

We have consulted the authorities cited to the point—but have found none that would sustain appellees' contention. Appellant did not allege the special defenses on which it would have had the burden of proof.

The trial Court did not reject appellant's evidence and *did not make any finding that appellant's predecessor had not appropriated VOODOO in 1934 as appellant's evidence clearly demonstrates.*

Appellees cannot, of course, argue that their registrations have become incontestable.



Without regard to any question of technical "burden of proof," it is clear appellant established appropriation in 1934 and use thereafter by its predecessor and itself by every species of proof conceivable in the circumstances.

**7. The asserted "background" of appellant (pp. 20-23).**

The entire travail here relates to third persons as asserted to have been related to appellant's predecessor, and to dates anteceding the existence of appellant by at least three years and the institution of the instant action by at least eight years!

Temporarily omitting consideration of the principles outlined in the opening brief: (1) that a successor is not perpetually shackled with the conduct of a predecessor, whatever it may have been, (2) that laches and limitations ultimately terminate contention over, even good, claims and (3) that evidence must relate to the issues and the parties before the Court and not to third persons and unrelated transactions—still appellees' discourse at this place does not hang together.

First, the meeting of Mr. Rolley with the District Attorney in 1943 is greatly overstated and overplayed. It was a conference with regard to some new amendments to the California statutes relating to comparisons in advertising of products of different manufacturers (TR 195); no charges were filed, much less tried and sustained. There arises, therefore, a presumption in law that official duty had been properly

performed, hence, that Mr. Rolley had not violated any law or statute of California or of the United States.

Further, there is a similar presumption, applicable everywhere, that a private person takes due care as to his private concerns, hence, that the twenty-nine odd perfumers appellees now cry for did not consider any conduct of Mr. Rolley, appellant's predecessor, at fault with regard to any of the matters appellees here recite.

Certainly, the many reputable firms appellees delight in naming are as competent, well advised and as jealous of their products' reputations as appellees could be and we must assume that, had they been injured, they would have known how to seek redress. Appellees do not have a monopoly in trade-mark litigation, though it is apparent they are more than ordinarily litigious.

Finally, there is the presumption, ever present, that wrong has not been done or intended, and the contrary was not shown here.

Moreover, we know of no decent basis for taking Mr. Rolley to task because, as appellees claim, Coty had registered a French surname which, pronounced with the French habit of dropping the final consonant, so resembled the name with which Mr. Rolley was born and christened that he was denied the right to register his own name as the manufacturer of perfumes. Patently, the result would not have been sustained, had the matter been litigated in any Court of general jurisdiction.



Appellees then quote from the case of

*Penn Co. v. M. L. B. & T. Co.*, 72 Fed. 422, without analysis or page reference to the effect that, in attempting to prove commission of a crime, the existence of common pattern, design, scheme, etc., may be shown for the limited purpose of showing knowledge and intent!

But here there is no crime, no fraud, no evil intent—Mr. Rolley, and later his assignee, engaged in the open, notorious and legitimate manufacture and sale of perfumery products under a name discovered and suggested by Mrs. Rolley, at least four years before the name had occurred to any other perfumer, much less appellees, and certainly not used or registered by anyone, anywhere! This name they continued to use in an open and proper manner for not less than 17 years and appellant was, in fact, the person who challenged appellees' unlawful infringement upon the first use by anyone other than Mr. Rolley and appellant of the name VOODOO.

It is quite true, as appellees repeatedly state, that Mr. Rolley—unlike appellees—did not have a staff of patent and trade-mark specialists employed and did not, therefore, make any litigation search for VOODOO before appropriating the name as a trade-mark, but he did, however, make a careful search of the market to determine that no product was being sold under that name. *But the important consideration, which completely escapes appellees, is that such a search in 1934, and at all times thereafter and until the latter part of 1938, would have proved fruitless,*

*because there was then no registration and no one else had appropriated the name to any perfumery product!*

The trial Court was misled by all this diffusion and concluded—not that Mr. Rolley and appellant had not appropriated and used the name before any one else—but that “he had violated the law” with regard to the third persons called to the aid of appellees and that, for that reason only, appellant should be denied relief on the cross-complaint.

**8. The “analysis” of appellant’s evidence (pp. 23-30).**

Examination discloses that appellees have not discovered any references to the record not adverted to in the statement of the case in appellant’s opening brief and here but “argue” the evidence. Since the trial Court did not reject appellant’s evidence and did not find to the contrary, we do not discern any service to the Court in setting forth a seriatim refutation of the unsupported conclusions appellees seek to draw from such evidence. That discussion should have been addressed to the trial Court and appellees’ convictions upon the evidence, if they have any, reflected in the finding they presented to the trial Court.

We note only the gratuity (page 30) that appellant “would ride on” appellees’ advertising—when the proof is demonstrative that *there was no such advertising* of VOODOO for the first fifteen years, and more, of Mr. Rolley’s and appellant’s sale of its products under the VOODOO name and label!

**9. The further discussion of registration (pp. 31-32).**

The argument here made is not readily comprehended. Apparently, appellees contend that appellant had the burden of proving, not only that the appropriation and use it claims preceded that of appellees by four or more years, but that, in addition, appellant should prove that no one in the world, from the beginning of time, ever used VOODOO in relation to a perfumery product. This extravagance collapses of its own lack of substance. Appellant had only to prove that it had ownership by appropriation and use prior to that of appellees' earliest predecessor, which it did demonstrate. The relative rights of appellant and some unknown and unidentified third person can be established in the event such third person infringes appellant's trade-mark. It is of no concern to appellees.

Appellant's only obligation in this case is to meet the claims of appellees, as the plaintiffs in the case, by showing that the appropriation and use it claims is prior to that asserted by appellees.

**10. The discussion of the cases (pp. 34-37).**

As we have presented our analysis of the cases appellant specially relies upon in the opening brief, we do not repeat our discussion here. Apparently, appellees do not, as well they cannot, dispute the basic principles declared in the cited decisions.

Appellees appear to suggest (page 35, et seq.) that appellant is bound by the presumptive investigation and inquiry of the registering agencies. This illusion

is adequately dispelled by the pragmatic example before the Court, e. g., a "registration" was accomplished in California *after* the dispute between the instant parties had not only developed, but had, in fact, been recorded in a series of communications, when, as no party to this record will contest, appellant had already used the trade-mark VOODOO throughout the state and elsewhere for 15 or more years.

Absent the sale and advertising of products under the name VOODOO in the west, only the subscribers of the official publications of the United States Patent Office could be expected to learn of appellees' various applications. While presumptive notice is essential to many governmental functions, it is a naive credulity which assumes that every citizen, or every merchant, in the United States has an actual knowledge of the myriad entries in the official register.

Not much can be predicated on this kind of "notice" in any case and only as to matters later than such notice, but here, where a common law right is recognized upon the original appropriation and continued use for years prior to such applications—there is neither occasion for detailed study of such publications nor any disability by reason of its omission.

In all events, registration, like other forms of constructive notice, is prospective, rather than retroactive in effect and, constitutionally, must be so.

See

*The Trade Mark Cases*, 100 U.S. 82.

11. The cases originally cited by appellees (pp. 37-38).

We have examined these cases and find that none of them has any bearing upon the questions here presented. It may be said for appellees that, in this instance, they do not actually claim the cases cited by them support the judgment. Each of them patently involved deliberate adoption of an established and well known trade-mark by one not pretending to any prior appropriation or use—much less the first appropriation, continued use for at least four years before any purported registration, and an over-all use continuously for so much as seventeen years.

Comparison of appellant's established rights with the come lately piracy of legitimate trade-marks involved in these cases is so far from the course that appellees themselves do not attempt it.

12. The claim the "public" associates **VOODOO** with appellees (pp. 38-41).

At this point appellees leave the record for good. There was not one retailer, nor one consumer, nor one advertiser, nor one expert called to support this argument. If, in fact, there could be any association of **VOODOO** with appellees—it could not have been so for so much as one year, actually only the Christmas season of 1949, whereas appellant's sales had continued for fifteen years and its products were widely known in the areas wherein it had developed distribution. Appellees' statement of their contention concedes this by omission of all reference to times and places and their proof is lacking in supplying any foundation for such an argument.



By contrast, appellant produced its actual purchasing customers, purchasing VOODOO products from its predecessor for a decade!

Who is to say what the public thinks, without some semblance of proof? If appellees were right, it would have been an easy matter to have produced at least one member of the purchasing public to support this claim.

**13. The adjudication argument (p. 42).**

It is here remarked that appellees have litigated their claims to TABU and VOODOO as against third persons. All that proves is that appellees are aggressive, perhaps unusually so. As the record does not show the facts of these cases, we cannot adequately discuss them. Appellees seem content to say only that they sued third persons and were successful. We see no occasion for this Court to notice these matters, whatever their facts, since they do not relate to priority of appropriation and use as between appellant and appellees and that is the only point to be decided herein.

**14. The dismissal of the cross-complaint (pp. 42-44).**

The reversal herein will reinstate the cross-complaint and, for that reason, there is little need to comment on the error in dismissing the cross-complaint, for the exclusive reason that appellant's predecessor had "violated the law" with respect to third persons and at times prior to 1943. It may be noted, however, that it was error to dismiss after issue

joined and plenary proof and, in any event, there should have been responsive findings and a judgment on the issues—even if appellant could not prevail.

**15. The preliminary injunction (pp. 44-46).**

This order, from which no appeal was prosecuted, has been final for nearly a year and we see no occasion to resurrect it. It may well be that the order was sustainable as a preliminary order based upon the balancing of the equities of presumably innocent third persons unwittingly participating with appellees in the latter's infringement of appellant's trademark VOODOO. But a final judgment is another matter. Appellant has not argued this item at length, and does not do so now, for the reason that this provision of the decree will fall with the reversal of the principal holding as an incident thereof.

**16. The claim appellant had a fair trial (pp. 46-47).**

Appellees provide no references to the record or to controlling authority not adverted to in the opening brief. It is tacitly conceded that it was error to try the cases of third persons with respect to unsupported contentions of wrongdoing by appellant's predecessor in interest, and no effort is made at rehabilitation of the rulings during trial. Nor is it denied that the trial Court did, in fact, determine the case upon the misconception that the Court was somehow precluded from ruling as the conscience of the chancellor dictated, by reason of such asserted wrongdoing of another in the long ago.



The point is, the trial Court was misled into error by appellees' overreaching and abused its discretion in not granting a new trial to correct the miscarriage. How can any auditor disabuse his mind of some 29 separately asserted "infringement" suits intruded upon him. It would be different had appellant acquiesced in this travesty, but it did not do so and objected repeatedly. Appellees cannot complain if their conscious and intransigent overreaching has fatally fouled their advantage so unfairly acquired. The chancellor should have obeyed his conscience, and this Court must reverse with the remand that he do so.

---

#### CONCLUSION.

It is respectfully submitted that the decree and writ should be reversed for each of the reasons set forth in appellant's opening brief.

Dated, San Francisco, California,  
December 12, 1952.

HARRY GOTTESFELD,  
JOSEPH A. BROWN,  
HUTCHINSON & QUATTRIN,  
By J. ALBERT HUTCHINSON,  
*Attorneys for Appellant.*

